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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,876	12/30/2003	Susan Matthews Brown	017242-002263US	8436
20350	7590	04/04/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			GROSZ, ALEXANDER	
			ART UNIT	PAPER NUMBER
			3673	

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/748,876	<b>Applicant(s)</b> BROWN ET AL.	
	<b>Examiner</b> Alexander Grosz	<b>Art Unit</b> 3673	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/27/04
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. <u>2/16/05</u>                                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/27/04</u>  | 6) <input type="checkbox"/> Other: _____                                    |

The status of parent S.N. 09/799,759 must be updated, in paragraph 1.

In paragraph 1 of the application, "continuity" is claimed from 09/799,759, while on the "utility patent application transmittal" form, box 18, the pending application is identified as a "continuation" of 10/046,377. Clarification is required.

On page 16, line 32, "wall 134" must be changed to -well 134-.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the term "generally orthogonal" must be inserted in the specification.

As method claims are presented, the abstract must set forth some method steps.

The terminal disclaimer filed on 12/27/04 has been approved.

Newly submitted claim 15 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claim is an (apparatus) pillow claim, not a method of using a pillow, as set forth in restriction requirements in parent applications.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 15 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Fanto-Chan or Zenoff, both teaching the use of generally U-shaped pillows in supporting methods for a user's torso, but not specifying the use of an internal dividing wall, in view of Emery or Worcester, both teaching the use of internal dividers for inflatable pillows.

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to have used a divider in Fanto-Chan's or Zenoff's pillows, because Emery and Worcester recognize the desirability of using dividers in inflatable pillows, in order to control their support characteristics.

It is noted that in method claims, limited patentable significance is given to structural limitations in articles that are used to implement the methods.

Applicant's arguments filed 12/27/04 have been fully considered but they are not persuasive. It is further noted that as discussed by applicant on page 16, lines 33, 34 and page 17, lines 6, 7 the orthogonal orientation of the walls, and their size, may vary from the claimed orientation and sizes.

While Emery and Worcester do not recite specific sizes for their walls, they do disclose pillows, just like applicant, and pillows, to be used by humans in various supporting methods, suggest sizes in the broad ranges claimed by applicant.

It is again noted that the claimed method steps are taught by Fanto-Chan and Zenoff, and in method claims limited patentable significance can be given to what

appear to be minor structural limitation differences (e.g. orthogonal orientation of walls) in the articles that are used to implement the claimed method steps.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Meinwieser and Post, teaching the use of conventional inflatable cushions with internal walls are cited as relevant art.

Any inquiry concerning this communication should be directed to Alex Grosz at telephone number 571-272-7041.

Grosz/vs  
March 30, 2005

ALEXANDER GROSZ  
PRIMARY EXAMINER

